

REMARKS

Claims 1-40 have been canceled without prejudice or disclaimer. Claims 41-50 have been added and therefore are pending in the present application.

It is respectfully submitted that the present amendment presents no new issues or new matter and places this case in condition for allowance. Reconsideration of the application in view of the above amendments and the following remarks is requested.

I. The Objection to Claim 26

Claim 26 is objected to under 37 CFR 1.75 as being a duplicate of claim 22. The newly presented claims render this objection moot.

Applicants respectfully request reconsideration and withdrawal of the objection.

II. The Rejection of Claims 30-32 and 39 under 35 U.S.C. 112 (Indefiniteness)

Claims 30-32 and 39 are rejected under 35 U.S.C. 112, as indefinite for a number or grounds (broad limitation recitation together with a narrow limitation and the phrase "altered stability"). The newly presented claims render these rejections moot.

For the foregoing reasons, Applicants submit that the claims overcome this rejection under 35 U.S.C. 112. Applicants respectfully request reconsideration and withdrawal of the rejection.

III. The Rejection of Claims 21-26, 28-32 and 38-40 under 35 U.S.C. 112 (Written Description)

Claims 21-26, 28-32 and 38-40 are rejected under 35 U.S.C. 112 as lacking written description support.

In order to expedite prosecution, the newly presented claims recite that the alpha-amylase variant has "at least 90% homology to SEQ ID NO.8." It is respectfully submitted that the specification provides written description support for the subject matter claimed in the new claims.

The written description requirement of the Patent Code is fulfilled when the patent specification describes the claimed invention in sufficient detail such that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See *Vas-Cath, Inc. v. Mahurkar*, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). The written description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary

has been presented by the examiner to rebut the presumption. See *In re Marzocchi*, 169 USPQ 367 (CCPA 1971).

The specification discloses, and one skilled in the art would recognize, that the scope of the present invention includes alpha-amylases having at least 90% homology to SEQ ID NO:8. Examples of alpha-amylases falling within the scope of the claimed invention include alpha-amylases having conservative amino acid substitutions in the amino acid sequence of SEQ ID NO:8, which are clearly envisioned by an artisan once apprised of Applicants' invention, as well as the many alterations disclosed in the specification on, e.g., pages 13-26. Moreover based on the high level of skill in the art, the phrase "alpha-amylase having at least 90% homology to SEQ ID NO:8" itself conveys to the artisan that Applicants were in possession of the claimed invention.

For the foregoing reasons, Applicants submit that the claims overcome this rejection under 35 U.S.C. 112. Applicants respectfully request reconsideration and withdrawal of the rejection.

IV. The Rejection of Claims 21-26, 28-32 and 38-40 under 35 U.S.C. 112 (Enablement)

Claims 21-26, 28-32 and 38-40 are rejected under 35 U.S.C. 112 as lacking enablement. This rejection is respectfully traversed.

The Examiner states that although the specification enables a variant alpha-amylase having at least 90% homology to SEQ ID NO:8, that the claims are not enabled the broader family of alpha-amylases recited in the claims.

In order to expedite prosecution, the newly presented claims recite that the alpha-amylase variant has "at least 90% homology to SEQ ID NO.8." It is respectfully submitted that the scope of the claims is commensurate in scope with the subject matter indicated by the Examiner to be enabled.

For the foregoing reasons, Applicants submit that the claims overcome this rejection under 35 U.S.C. 112. Applicants respectfully request reconsideration and withdrawal of the rejection.

V. The Rejection of Claims 21, 22, 24-26, 28-31 and 40 under 35 U.S.C. 102(b) (Outtrup et al.)

Claims 21, 22, 24-26, 28-31 and 40 are rejected under 35 U.S.C. 102(b) over Outtrup et al.). Outtrup et al. is cited as teaching alpha-amylases of *Bacillus* strains NCIB 12513 and NCIB 12512. The Examiner states that these alpha-amylase can be considered to be variants of the alpha-amylase of SEQ ID NO:8.

Outtrup et al. does not teach an alteration of a position corresponding to position 170 in SEQ ID NO:8. Moreover, in order to expedite prosecution, the newly presented claims recite that the alpha-amylase variant has "at least 90% homology to SEQ ID NO:8." Outtrup et al. does not teach alpha-amylase variants having this degree of homology to SEQ ID NO:8.

For the foregoing reasons, Applicants submit that the claims overcome this rejection under 35 U.S.C. 102(b). Applicants respectfully request reconsideration and withdrawal of the rejection.

VI. The Rejection of Claims 21, 24, 28, 30, 31, 38 and 40 under 35 U.S.C. 103

Claims 21, 24, 28, 30, 31, 38 and 40 are rejected under 35 U.S.C. 102(b) as being over Svendsen et al. Svendsen et al. is cited for teaching a *B. amyloliquefaciens* alpha-amylase having a substitution of amino acids 121-174 (which includes a position K168 corresponding to position 170 of SEQ ID NO:8) for the amino acids 102-199 of FUNGAMYL.

In order to expedite prosecution, the newly presented claims recite that the alpha-amylase variant has "at least 90% homology to SEQ ID NO:8." The *B. amyloliquefaciens* alpha-amylase variant above has less than 90% homology to SEQ ID NO:8 and therefore does not anticipate the claims.

For the foregoing reasons, Applicants submit that the claims overcome this rejection under 35 U.S.C. 102(b). Applicants respectfully request reconsideration and withdrawal of the rejection.

VII. The Rejection of Claims 21, 24, 28-31, 38 and 40 under 35 U.S.C. 102(e) (Andersen et al.)

Claims 21, 24, 28-31, 38 and 40 are rejected under 35 U.S.C. 102(e) as anticipated by Andersen et al.

The claims of the instant application are rejected under 35 U.S.C. 102(e) over Applicants' US Patent Publication 2003/0129718. The US Patent Publication and instant application contain a common inventor (Carsten Andersen), and accordingly, the US Patent Publication may not be prior art of "another." Applicants are investigating whether the invention disclosed but not claimed in this cited reference was derived from the common inventor and whether inventorship of the instant application or the cited reference is proper. A Petition and Fee For Suspension of Action By Office is submitted herewith. The Petition requests suspension for a period of two months to complete the investigation.


Applicants intend to submit an appropriate supplemental response.

VIII. Conclusion

In view of the above, it is respectfully submitted that all claims are in condition for allowance. Early action to that end is respectfully requested. The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this amendment or application.

Respectfully submitted,

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